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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838

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EXAMINER

SING, SIMON P

ART UNIT PAPER NUMBER

2645

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,265

Applicant(s)

KIMURA, ETSUKO

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 21, 25-27, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Wagner et al. US 6,169,911:

1.1 Regarding claims 21 and 27, Wagner discloses a portable telephone 1 in figures 1 and 2, comprising:

a memory (storing means) 21 which stores at least two functions (Email of figure 5, and Stock of figure 9) and at least two items (items New and Reply for Email, and Profile and Chart for Stock) hierarchically assigned to each function;

a display (displaying means) 4 (figure 1; column 2, lines 59-67) which displays:

- a) a function (figure 9, Stock);
- b) a first item "Profile" assigned to the displayed function (figure 9; and
- c) a second item "Chart" assigned to the displayed function;

a first button 5, corresponding to the displayed first item "Profile", wherein the pressing of the first button indicates the selection of the first item "Profile" when the display is displaying the first item "Profile" (column 5, lines 27-32);

a second button 6, corresponding to the displayed second item "Chart", wherein the pressing of the second button indicates the selection of the second item "Chart" when the display is displaying the second item "chart" (column 5, lines 27-32);

wherein,

when the display is not displaying the first item "Profile", the pressing of the first button indicates one or more actions unrelated to the first item "Profile" (figure 7, item "No"), and

when the display is not displaying the second item "Chart", the pressing of the second button indicates one or more actions unrelated to the second item "Chart" (figure 7, item "Ok").

1.2 Regarding claims 25 and 31, Wagner teaches that the soft-key buttons 5 and 6 are directly below the displayed first item and the second item respectively (column 5, lines 27-32).

1.3 Regarding claims 26 and 32, Wagner teaches a portable telephone, which is a cellular phone (figure 1; column 2, lines 59-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. US 6,169,911 in view of Nuovo et al. US 6,097,964.

Wagner teaches two soft-key buttons 5 and 6, but fails to teach a key tone function associated with these two buttons.

However, Nuova discloses a cellular phone 1 in figure 1 (column 4, lines 29-36), comprising two soft keys 8. Nuova teaches that a user may assign favorites, including key tone on/off, to a soft key menu (column 12, lines 58-67; column 13, lines 1-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wagner's reference with the teaching of Nuovo, so that a key tone function with ON and OFF child functions would have been

added to the a soft key menu, such that when the key tone function was activated by a user, the key tone function with a first item (ON) corresponding to a first soft-key button and a second item (OFF) corresponding to a second soft-key button would a have been displayed, and when a sort-key button was pressed, the corresponding item (ON or OFF) would have been selected, because how to arrange the display of soft-key functions would have been a matter of design choice.

3. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. US 6,169,911 in view of Nishihara US 5,561,712.

Wagner teaches two soft-key buttons 5 and 6, but fails to teach an automatic power function associated with these two buttons.

However, Nishihara discloses a cellular telephone in figure 5 with a plurality of built-in functions, including automatic power-on and power-off (column 8, lines 19-25; columns 11 and 12, table 1-3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wagner's reference with the teaching of Nishihara, so that an automatic power function with ON and OFF child functions would have been added to the a soft key menu, such that when the automatic power function was activated by a user, the automatic power function with a first item (ON) corresponding to a first soft-key button and a second item (OFF) corresponding to a second soft-key button would a have been displayed, and when a sort-key button was

pressed, the corresponding item (ON or OFF) would have been selected, because how to arrange the display of soft-key functions would have been a matter of design choice.

4. Claims 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. US 6,169,911 in view of Anderson et al. US 5,737,394.

Wagner teaches two soft-key buttons 5 and 6, and an address book function (figure 3A), but fails to teach that the soft-key buttons act as cursors.

However, Anderson discloses a portable telephone 10 in figure 2 (column 3, lines 34-38, 52-58) with soft-key buttons 20 (column 4, lines 3-8; column 5, lines 39-49). Anderson teaches a (address) book function (column 3, lines 34-38) and when the address book function is activated, the soft-key buttons become cursors (figure 8, steps 380-430).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wagner's reference with the teaching of Anderson, so that an address book function was activated, the soft-key buttons 5 and 6 would have become cursors, because such a modification would have enabled a user to edit the entries of the address book.

Response to Arguments

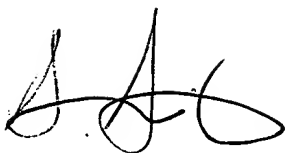
5. Applicant's arguments with respect to claims 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (571) 272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.



FAN TSANG
SUPERVISORY PATENT EXAMINER
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S. Sing

04/21/2005